

MILAN LOCAL DIVISION



UPC_CFI_472/2024

ACT_45469/2024

Appl. No.: 5885/2025

Preliminary Order n. _5965/2025

of the Court of First Instance of the Unified Patent Court

delivered on February 7, 2025

In the proceedings brought by

Dainese S.p.A. Claimant

against

Alpinestars S.p.A. Defendant 1

Alpinestars Research S.p.A. Defendant 2

Omnia Retail S.r.l. Defendant 3

Horizon Moto 95 - Maxxess Cergy Defendant 4

Zund.Stoff Augsburg/Ulrich Herpich E.K. Defendant 5

Motocard Bike S.l. Defendant 6

Proprietor/s

PATENT AT ISSUE

Patent no.

EP4072364 Dainese S.p.A.

EP3498117 Dainese S.p.A.

LANGUAGE OF PROCEEDINGS: English

DECIDING JUDGE

Judge-rapporteur **Alima Zana**

COMPOSITION OF PANEL – FULL PANEL

Presiding judge **Pierluigi Perrotti**

Judge-rapporteur **Alima Zana**

Legally qualified judge **Anna-Lena Klein**

Technically qualified judge **Graham Ashley**

Headnotes

1. The position of the party attacking the patent shall be protected in the proceedings to the same extent as that of the party defending the patent.
2. Using the power of case management, which includes encouraging the parties to cooperate with each other during the proceedings (see Rule 332(a) of the Rules of Procedure), and pursuant to Rule 9(1) of the Rules of Procedure, the parties are invited to submit a -possibly joint -request for the alignment of future procedural deadlines,

Keywords ***RULE 332 ROP***. Rule 9, para 4, ROP,

Summary of facts

-On February 4, 2025, Dainese filed an application under rule 9 RoP requesting to extend the deadline for lodging the Defence to Counterclaims for revocation and the Reply to the statements of defence filed by Defendant 2 and Defendant 6 until February 27, 2025.

The applicant specified that:

- the deadline for filing the Defence to Counterclaims for revocation and the Reply to the statements of defence filed by Defendant 2 and Defendant currently is set to expire on 13 February, 2025;
- In parallel, the oral hearing in the appeals proceedings regarding the opposition against EP 3 498 117 ("EP 117") brought by Defendant 1 before the EPO is currently scheduled for 13 February 2025;

- By order dated January 15, 2025 the Court allowed, according to the defendant 1 application, postponed the deadline for filing the statement of defense to **February 27, 2025**, to enable the knowledge and the examination of the decisions of the EPO and thus the coordination with them
- The same reasons for coordination, expressed by the Court of Justice, are invoked to protect the plaintiff's positions and result in the application being granted.

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By order filed on February 4 2025, the Judge rapporteur invited the other parties to comment the application.

Defendants n. 2 and 6 requested:

- to reject Dainese's request.
- that only the deadline for filing the reply to the Statement of Defence and Counterclaim for Revocation of Defendant 6), currently set to expire on 20 February, is postponed to 27 February of knowledge and examination of the decisions of the EPO.

The respondents specified that:

- the current deadlines that the Claimant has asked to extend expire a few days before or after an oral hearing set before the EPO is solely a consequence of the Claimant's decision to assert a patent that is subject of an opposition proceedings.
- defendants n. 2 and n. 6 proposed to Dainese to ask the Court to harmonize the different deadlines for filing the Defendants' Statements of Defence: - Nevertheless Claimant refused to agree to such a request.
- requesting a postponement of the deadline under Rule 29 (a) for the sole purpose of understanding how to reply to Defendants' counterclaims for revocation is simply a misuse of the procedural rules, and an order granting such a request would be unbalanced and would unduly undermine the counterclaims filed by Defendants 2) and 6).
- Moreover, neither Defendant 2) nor Defendant 6) have benefited from a comparable extension of deadline and they have already filed their statement of defence with counterclaims for revocation;

General consideration

This order is adopted in accordance with:

(i) the following principles set out in the Preamble 2 of the RoP

- proportionality, flexibility and fairness.

(ii) Rule 9, para 4, ROP (“ *Subject to paragraph 4, on a reasoned request by a party, the Court may: (a) extend, even retrospectively, a time period referred to in these Rules or imposed by the Court; and (b) shorten any such time period. 4. The Court shall not extend the time periods referred to in Rules 198.1, 213.1 and 224.1*”);

(ii) Rule 118 RoP the Court (..) (b) *may stay the infringement proceedings pending a decision in the revocation procedure or a decision of the European Patent Office and shall stay the infringement*

proceedings if it is of the view that there is a high likelihood that the relevant claims of the patent will be held to be invalid on any ground by the final decision in the revocation proceedings or of the European Patent Office where such decision of the European Patent Office may be expected to be given rapidly

(iii) Rule 295 let. A, RoP “(The Court may stay proceedings where it is seized of an action relating to a patent which is also the subject of opposition proceeding or limitation proceedings (..) before the European Patent Office”).

(iv) Art. 33(10) UPCA (“A party shall inform the Court of any pending revocation, limitation or opposition proceedings before the EPO, and of any request for accelerated processing before the EPO. The Court may stay its proceedings when a rapid decision may be expected from the EPO”);

(v) rule 332, lett. a, RoP “– General principles of case management Active case management includes: (a) encouraging the parties to co-operate with each other during the proceedings;

The case at hand

1. The Judge rapporteur notes that for the sake of consistency, the postponement requested by the plaintiff should be granted taking into account the reasons expressed in the order no. ORD_1495/2025, as following.

“The mandatory coordination between the appeals proceedings before the EPO and the proceedings before the UPC in this case may be achieved in the most efficient way, taking into account the position of all parties, by extending the time limits for filing the statement of defence and the counterclaim for revocation.

The Judge rapporteur notes that the requested extension allows for a more overall procedural efficiency, on one hand not staying these proceedings – power of the Court- and on the other hand waiting for the upcoming EPO’s decision.

The principle of efficiency is therefore guaranteed, at the same time guaranteeing the right to a full adversarial principle, which in the present case also takes the form of knowledge and examination of the decisions of the EPO.

Dainese's exceptions are unfounded having regard that:

-the solution adopted is not merely to stay the proceedings, but a flexible solution, respecting the procedural rights of all parties.

- On a reasoned request by the other parties, both the plaintiff and the other defendants, they may be granted a period within which to submit their observations on the EPO's decision, in accordance with the procedural faculty provided for in Rule 36 of the Rules of Procedure. It follows that the solution adopted does not violate the adversarial principle and complies with the equality of the parties in the right of defence.

-Defendant 1’s procedural choice to request an extension of the deadline only in January 2025 will not lead to any significant delay in the proceedings, taking into account in any event the need to verify the outcome of the proceedings before the EPO.

Finally, the extension until 27 February 2025 appears to be consistent with the need to await the EPO's decision, examine it and prepare appropriate defences before the Court.

in the present case, service of the Statement of Claim was delayed for one of the three defendants. According to Rule 23 RoP, the time limit for filing the Statement of Defence is within three months of service of the Statement of Claim. Due to the different times of service for the defendants, the Judge-Rapporteur of the LD decided that it is appropriate to align the deadlines for all defendants, thereby granting a deadline extension for filing the Statement of Defence in accordance with Rule 9.3 and Rule 334 (a) and (b) RoP.

The position of the party attacking the patent shall be protected in the proceedings to the same extent as that of the party defending the patent.

For the above reasons, the application is granted.

2. Having established this, the Judge-Rapporteur observes that, because of the different deadlines for service the statement of claim, the procedural timetables are not aligned and may lead to disregard for the procedural dialectic and the rights of the defence as laid down in the Rules of Procedure.

The Court points out that fairness and justice must be ensured having regard to the legitimate interests of all parties (see Preamble, point 5 of the Rules of Procedure).

It is therefore appropriate to harmonise the procedural deadlines to all defendants on the one hand and to the applicant on the other.

Using the power of case management, which includes encouraging the parties to cooperate with each other during the proceedings (see Rule 332(a) of the Rules of Procedure), and pursuant to Rule 9(1) of the Rules of Procedure, the parties are invited to submit a -possibly joint -request for the alignment of future procedural deadlines, including a deadline for Defendants Nos. 2 and 6 to supplement their defences, having filed the counterclaim for withdrawal prior to the decision of the EPO.

ORDER

1. the deadline for Dainese (the claimant n. 1) for lodging the Defence to Counterclaims for revocation and the Reply to the statements of defence filed by Defendant 2 and Defendant 6 is extended until February 27, 2025.
2. parties are invited to lodge a – possibly joint - request for the alignment of future procedural deadlines, including a time limit for defendants Nos. 2 and 6 to supplement their defences, having filed the counterclaim for revocation prior to the decision of EPO's Decision.

Delivered in Milan, February 7, 2025

The Judge rapporteur

Alima Zana

Order no. ORD_5965/2025 in ACTION NUMBER: ACT_45469/2024

UPC number: UPC_CFI_472/2024

Action type: Infringement Action

Related proceeding no. Application No.: 5885/2025

Application Type: Generic procedural Application